REMARKS

After entry of this amendment, claims 1-19, 21-35, and 38-45 are pending. In the present Office Action, claims 1-36 were rejected under 35 U.S.C. § 112, second paragraph. Claims 1-36 were also rejected under 35 U.S.C. § 101. Claims 1-37 were rejected under 35 U.S.C. § 102(b) as being anticipated by alleged Applicant Admitted Prior Art (AAPA). Claims 36-37 were rejected under 35 U.S.C. § 102(e) as being anticipated by Yu, et al., U.S. Patent No. 6,865,670 ("Yu"). Applicant has cancelled claims 36-37, and thus the rejection based on Yu is moot. Applicant respectfully traverses these rejections and requests reconsideration.

Applicant notes that the AAPA is <u>not properly classified as prior art under section 102(b)</u>. Section 102(b) requires that the invention be patented or described in a printed publication more than one year prior to the filing date of the present application, or public use or sale of the invention more than one year prior to the filing date. The mere inclusion of the AAPA material in the background of the present application does not prove the publication/patenting nor the public use/sale of the AAPA <u>more than one year</u> prior to the filing of the present application.

<u>The Claims are Patentable over the AAPA</u>

Applicant respectfully submits that each of claims 1-19, 21-35, and 38-45 recite combinations of features not taught or suggested by AAPA. For example, claim 1 recites a combination of features including: "<u>a first vendor generating one or more files corresponding to an integrated circuit designed by the first vendor,</u> ... a content of the one or more files is <u>structured for at least one of: (i) incorporation into a boot code sequence; or (ii) access by the boot code sequence during execution</u>".

The AAPA does not teach or suggest the above highlighted features. Rather, the AAPA teaches the following with regard to vendors that design integrated circuits (referred to as chip vendors or integrated circuit vendors in the AAPA): "Typically, the integrated circuits included in a given system are developed by one or more integrated circuit vendors. The boot code sequence (e.g. BIOS code) for the given system is

9

developed by a BIOS vendor." (Specification, page 2, lines 5-7). Original equipment manufacturers (OEMs) that develop systems using the integrated circuit are also described as developing or modifying boot sequence code (Specification, page 2, lines 9-13). Thus, the integrated circuit vendor does not develop boot sequence code in the AAPA.

Instead, the integrated circuit vendor in the AAPA provides "documentation of the registers in the integrated circuit, and the values to which the registers are to be initialized by the BIOS code" (Specification, page 2, lines 14-15). This human-readable documentation is not one or more files "structured for at least one of: (i) incorporation into a boot code sequence; or (ii) access by the boot code sequence during execution". Rather, the documentation (and any updates to the documentation) are interpreted by humans which manually change the boot sequence code in an error-prone attempt to successfully initialize the integrated circuits (see, e.g. Specification, page 3, lines 8-10; page 5, lines 2-4 and 13-16; and page 6, lines 1-3 and 26-39). Thus, in no case does the AAPA teach that information from the integrated circuit vendors is structured for incorporation into the boot code sequence or for access by the boot code sequence.

The sections of AAPA relied on by the Office Action to allegedly teach the above highlighted features of claim 1 refer to the BIOS vendors creation of the boot code. However, the BIOS vendors are not the designers of the integrated circuit. Accordingly, the BIOS vendors are not the vendors that designed the integrated circuit, as recited in claim 1.

For at least all of the above reasons, Applicant respectfully submits that the AAPA does not anticipate the features of claim 1. Accordingly, claim 1 is patentable over the cited art. Claims 2-19 depend from claim 1, and thus are also patentable over the cited art. Each of claims 2-19 recites additional combinations of features not taught or suggested in the cited art.

Claim 21 recites a combination of features including: "a first one or more instructions which, when executed, *generate* one or more files corresponding to an integrated circuit, the integrated circuit having one or more registers, wherein a content of the one or more files is structured for at least one of: (i) incorporation into a boot code sequence; or (ii) access by the boot code sequence during execution".

The Office Action asserts that the above mentioned files are configuration files, and the instructions which generate the configuration files are the BIOS/boot instructions. However, the AAPA has NO teaching that the BIOS/boot instructions GENERATE any configuration files. There is discussion of using table driven initialization (specification, page 6, lines 5-14, but these tables are HUMAN generated. There is also discussion of an algorithmic method (specification, page 6, lines 16-20). However, nothing in this discussion teaches configuration files, and definitely not configuration files generated by the BIOS/boot instructions. Certainly, there is no teaching the AAPA that the BIOS/boot instructions generate files corresponding to an integrated circuit, wherein the content of the one or more files is structured for at least one of: (i) incorporation into a boot code sequence; or (ii) access by the boot code sequence during execution, as recited in claim 21.

For at least all of the above reasons, Applicant respectfully submits that the AAPA does not anticipate the features of claim 21. Accordingly, claim 21 is patentable over the cited art. Claims 22-34 depend from claim 1, and thus are also patentable over the cited art. Each of claims 22-34 recites additional combinations of features not taught or suggested in the cited art.

Claim 35 recites a combination of features including: "receiving, from a first vendor, one or more files corresponding to an integrated circuit *designed by the first vendor*, the integrated circuit having one or more registers, wherein a content of the one or more files is structured for at least one of: (i) incorporation into a boot code sequence; or (ii) access by the boot code sequence during execution". The same teachings of the AAPA cited above for claim 1 are alleged to teach the above highlighted features of

claim 35. Applicant respectfully submits that the AAPA does not teach or suggest the above highlighted features of claim 35, either. Accordingly, claim 35 is patentable over the cited art. Claims 38-45 depend from claim 35, and thus are also patentable over the cited art. Each of claims 38-45 recites additional combinations of features not taught or suggested in the cited art

Section 112 Rejections

Claims 1-36 were rejected under section 112 based only on alleged clarity issues with the independent claim, as well as a rejection of claim 25 for lack of antecedent basis. Applicant has amended claim 25, and submit that the amendment addresses the rejection. Applicant respectfully traverses the rejection of the independent claims.

With regard to claim 1, the Office Action asserts that the claim is totally confusing because the relationship of "a first vendor generating one or more files corresponding to an integrated circuit, the integrated circuit having one or more registers, wherein a content of the one or more files is structured for at least one of: (i) incorporation into a boot code sequence; or (ii) access by the boot code sequence during execution" is insufficiently defined or incomplete for omitting essential structural cooperative relationships of the elements, such omission amounting to a gap between the necessary structural connections or showing insufficiency or missing essential elements or steps to define the relationship among them.

Applicant respectfully disagrees. Claim 1, while broad, is very clear and defines clear relationships among the recited features. As highlighted above, a first vendor generates one or more files that correspond to an integrated circuit. Thus, the files and the integrated circuit have a broad relationship to each other. Additionally, the integrated circuit has one or more registers. The content of the files is structures to be incorporated into a boot code sequence or accessed by the boot code sequence. Accordingly, the structure of the file is one that permits the boot code sequence to either incorporate the file or access the file. Again, a broad relationship is clearly stated between the boot code sequence and the file structure. Finally, claim 1 includes additional features not

12

mentioned in the section 112 rejection. Specifically, claim 1 states that the boot code sequence is configured to initialize the one or more registers responsive to the content during execution. Thus, a broad relationship between the boot code sequence and the registers (of the integrated circuit) is stated. There is nothing even remotely unclear about the relationship between various features of claim 1. Applicant respectfully reminds the Examiner that breadth is not indefiniteness (see MPEP 2173.04). No essential material is omitted. If the Examiner believes differently, Applicant invites the Examiner to identify such alleged essential material.

Accordingly, Applicant respectfully requests that the section 112 rejection of claim 1 be rescinded. The rejection of claims 21 and 35 is along similar lines to the rejection of claim 1. Applicant respectfully submits that, for reasons similar to those given above, the rejection of claims 21 and 35 should be rescinded. Applicant disagrees with the rejection of claim 36, but notes that claim 36 has been cancelled and thus the rejection is moot.

Section 101 Rejections

Claims 1-36 were rejected in light of the section 112 rejection as raising a question as to whether the claims are directed to an abstract idea that is not tied to a technological art which would lead to a useful, tangible result. Applicant has addressed the section 112 rejection above. Furthermore, Applicant submits that claims 1-36 are tied to a technological art (electronic systems containing integrated circuits) and particularly relate to the useful, tangible result of initializing integrated circuits in such systems, so that such systems can operate properly. For example, claim 1 recites "the boot code sequence is configured to initialize the one or more registers (of the integrated circuit) responsive to the content during execution". Independent claims 21 and 35 include similar recitations. Accordingly, Applicant respectfully submits that the pending claims are statutory.

The Office Action also rejects claims 21-34 and 36, alleging that Applicant defines the computer accessible media as "media accessible via transmission media" or

13

"signals" citing the specification, page 27, lines 8-15. Applicant respectfully disagrees that the definition of computer accessible media includes non-statutory embodiments. The cited portion of the specification includes: "a computer accessible medium may include … *media accessible* via transmission media or signals such as electrical, electromagnetic, or digital signals, conveyed via a communication medium such as a network and/or a wireless link." Thus, the specification does not define the computer accessible medium as including signals or transmission media, but rather media that are accessible via signals. For example, the media may be accessed over a network or wireless link, and thus need not be part of the computer or inserted into the computer to be accessible to the computer. Accordingly, Applicant respectfully submits that the computer accessible medium is statutory. Nevertheless, the Office Action suggested that reciting a computer readable storage medium would overcome this rejection. Since such an amendment would not rule out storage media accessible via transmission media or signals, Applicant has elected to make the suggested amendment, and thus submits that the rejection is addressed.

CONCLUSION

Applicant submits that the application is in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5500-95300/LJM.

Also enclosed herewith are the following items:

☐ Return Receipt Postcard

☐ Petition for Extension of Time

☐ Request for Approval of Drawing Changes

☐ Notice of Change of Address

☒ Please debit the above deposit account in the amount of $250 for fees ($250 for 5 claims over 20).

☐ Other:

Respectfully submitted,

/Lawrence J. Merkel/
Lawrence J. Merkel, Reg. #41191
AGENT FOR APPLICANT(S)

Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C.
P.O. Box 398
Austin, TX 78767-0398
Phone: (512) 853-8800

Date: ___November 20, 2006

15